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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,388	05/03/2001	Isabelle Afriat	205731US0	6489
22850	7590	07/14/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				HAGHIGHATIAN, MINA
ART UNIT		PAPER NUMBER		
		1616		

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/847,388  
Filing Date: May 03, 2001  
Appellant(s): AFRIAT, ISABELLE

*Mailed out date  
7.14.04*

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For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 04/27/2004.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1, 3-20, 35, 36 and 43-47 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

6,306,407	CASTRO et al	10-2001
5,814,322	SEBILLOTTE-ARNAUD	09-1998

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-20, 35-36, 43-47 are rejected under 35 U.S.C. 103 over Castro et al (6,306,407) in view of Sebillotte-Arnaud (5,814,322). This rejection is set forth in a prior Office Action, mailed on 08/19/03.

**(11) *Response to Argument***

Appellant's arguments filed 04/17/2004 have been fully considered but they are not persuasive.

Appellant's basic argument is that neither of the cited references, by themselves, contains a sufficient disclosure upon which a §103 rejection could be based. Appellant believes that the examiner has attempted to combine their disclosures to cobble together a §103 rejection. Appellant also states that

examiner has used applicant's disclosure as a roadmap to find motivation to combine.

Examiner, respectfully disagrees with the Appellant's statements. As mentioned in previous Office Actions and previous responses to the arguments, Castro is clearly teaching the Appellant's invention. In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is **some** teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Castro, the primary reference, is teaching cosmetic and pharmaceutical compositions for topical application to the skin comprising fiberous component for promoting the transfer of moisture and oil and removal of unpleasant moisture from the skin (see abstract and summary). Castro teaches that the compositions will draw moisture and oil away from the surface of the skin (see summary). Castro discloses that "the resulting cosmetic and pharmaceutical compositions of the present invention manage unwanted oil on the skin" see col. 2, lines 49-51. Castro discloses that the fibers are treated to make them substantially hydrophobic, which means the fibers are lipophilic and oil-attracting and have great affinity for non-polar substances such as sebum (see col. 3, lines 9-15). Castro discloses various other components that are suitable for addition to the

said fibrous composition. Such components include amino acids, fatty acids, metal stearates, oil soluble actives, retinol and **the like** (see col. 6). Also Castro discloses that “the benefit of the present invention can also be obtained in non-make-up compositions, e.g. **treatment** products (see col. 5, lines 27-30). Clearly one of ordinary skill expects that a **pharmaceutical** composition for **treatment** of the skin, which is essentially **managing unwanted oil** of the skin to contain other active agents for removal of unwanted oil from the skin for added effect. Thus it is believed that the obviousness has been shown over the course of the prosecution.

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account **only** knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Again it has been shown that Castro is teaching the formulations of the instant application, lacking disclosure on the specific active agents of the instant Application. However, one of ordinary skill would be motivated to add other active agents to obtain a dual effect. For example Castro is disclosing the addition of “retinol and its derivatives, and the like”. Appellant is disclosing adding azelaic acid and its salts. Retinols and azelaic acid, although chemically different agents, are known in the art for

combating acne and related skin disorders thus considered to be in the same field of endeavor. Clearly one of ordinary skill in the art would be able to substitute one for the other.

Appellant argues that since Castro's fibers are in an oil carrier, and Sebillotte-Arnoud is disclosing active agents in a gel containing a hydrophilic carrier, one of ordinary skill would not be motivated to combine the two references. This is not persuasive. The preferred embodiments do not teach away from the broader disclosure. Although Sebillotte-Arnoud teaches gels containing a hydrophilic carrier, he also discloses addition of oils to the compositions. In fact he discloses that "it is possible to add one or a number of oils which are soluble or insoluble in the hydrophilic medium" (see col. 5, lines 19-22). He also discloses a list of **lipophilic** active agents capable of being introduced into the composition (see col. 6, lines 1-33).

Appellant states that some limitations of the dependent claims, such as the type of fiber, the length of fibers, the amount of active agents in the formulations are not taught by the cited references. This is not persuasive. Castro is clearly teaching all types of fibers, including blends of fibers and treated fibers (see col. 3) and the length of fibers (see col. 4, lines 16-18) (0.01 inch is equivalent to 0.254 mm). Castro is also disclosing, in example 1 that 1% of isostearyl palmitate, 2% of zinc stearate and 5% of pigments are used. These agents, individually or combined meet the limitation of 0.0001 to 30% of the instant claims.

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It is the examiner's position that Castro in view of Sebillotte-Arnoud is providing sufficient teachings and disclosure for one of ordinary skill in the art to make and use the formulations, as claimed in the instant application.

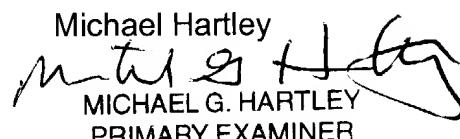
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

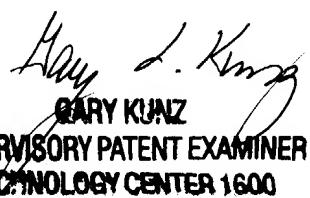


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July 12, 2004

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